

## REMARKS

By this amendment, applicant has amended claim 11 and cancelled claim 13. Claims 6-12, 14 and new claims 15 - 22 are presented in the application. Re-examination and reconsideration of the application is respectfully requested.

Claim 6 recites the feature of the player being able to call for reconstitution of the inventory. The Examiner has rejected claim 6 under 35 USC § 103 as being obvious in light of Fuchs view of Richardson. In regards to this rejection, the Examiner has quite correctly noted that "...Fuchs does not disclose allowing the player to call for reconstitution " (Office Action, page 5). In this regard, the Examiner cites Richardson disclosure for the proposition that the player is provided with an input device that can be used to call for a new deal.

Applicant respectfully traverses the Examiner's reading of Richardson and further avers that Richardson teaches away from the invention of claim 6.

In Richardson, the player is selecting "tickets" from a predetermined ticket set. As is known in the pull tab art to which Richardson is directed, the ticket set includes a predetermined number of tickets, e.g. 500, and each ticket has printed thereon a winning or losing outcome much like a scratch-off lottery ticket. The distribution of winning versus losing outcomes and the prizes for winning outcomes is predetermined such that the sale of the ticket set for the play of the game can produce a profit. Thus, for example, if there are 500 tickets in the pull -tab ticket set, and each ticket sells for \$1, the sale of all tickets would bring in \$500. To turn a profit, the sum of all winning outcome awards would be less than \$500.. Thus, the only thing in Richardson that is

random, is the selection of a ticket from the ticket set which is akin to pulling a ticket from bowl containing all tickets. The outcome for that selected ticket is not random. selected in the game since the symbols for that ticket are predetermined and were long ago printed on or determined (stored in memory) for the ticket and were chosen to conform to the profit criteria described above. Thus the symbols for the outcome (ticket) are NOT randomly selected from a data structure when the player makes the wager and prompts play. Nor is there any requirement to assess the indicia selected to determine whether the randomly selected indicia are a winning or losing outcome since, in Richardson, the ticket (representing the outcome), when printed or stored in memory (well before the purchase by the customer), was already determined to be a winner or a loser.

"Deal" as used in Richardson has a different meaning than randomly selecting indicia from a data structure of indicia to define an outcome as recited in Claim 6.

Richardson states:

"... he has the opportunity to select a new Deal Screen 28 ... with a new offering of nine chances" Col. 11, lines 48 49.

"This is the procedure of playing a deal only so long as at least one of the higher level winners ... remains available to be won within the deal." Col. 16, lines 31 - 34.

Thus "deal", in the context of Richardson, means either the display of chances (tickets) or the entire inventory of tickets for a particular pull - tab game. When Richardson refers to allowing a new deal after all of the tickets have been redeemed, he is referring to a new inventory set of pull tab tickets. For example, during the play of a pull tab

game (sale and revelation of the tickets of the inventory), the player does not have the opportunity to reconstitute the ticket set inventory. He must, if he wants to go to a game with more tickets left in the inventory, go to different "deal", i.e. inventory set. It should be understood that in pull tab games the number of tickets in the inventory is strictly controlled by gaming regulations. Thus in the pull tab art, allowing a player to add more tickets (reconstitute) to the set would not be permitted since the same would affect the overall performance of the game. For example, if the pull tab game had only sold 20% of the tickets but most of the prizes had been won, reconstituting the inventory of tickets would render the previous deal (ticket inventory set) unprofitable. Conversely, if a player could reconstitute the "deal" where the majority of major prizes remained, the previous "deal" would have represented an unfair windfall to the operator. Further, since Richardson is directed to tickets (outcomes) and not individual symbols (indicia of claim 6), and reconstitution, even if suggested by Richardson, would mean adding more outcomes, it is submitted that Richardson is not pertinent to the method of claim 6.

It therefore is submitted that Richardson teaches away from the present invention by (1) being directed to a pull tab game as opposed to a game where individual indicia are selected after the player's wager to define outcomes and (2) not permitting reconstitution of the original inventory of indicia data. It is respectfully submitted that those skilled in the art, and in connection with the method of claim 6, would have (1) turned away from Richardson since it is directed to a pull-tab game with a predetermined set of outcomes (tickets) which cannot be "reconstituted" since that would ruin the pre-set collection of winning and losing outcomes of the pull-tab game set, (2) allowing a player to re-stock the inventory of tickets of Richardson would render

Richardson inoperative since re-stocking after, for example, the sale of 10 tickets with the major prize awarded, would mean that the prior set would have taken in \$10 and possibly paid out \$100 in prizes rendering the game unprofitable.

It further is submitted that there is no suggestion for combining Richardson with Fuchs since the disclosures are directed to games with different features (Fuchs is a slot machine game and Richardson is a pull-tab game) and the failure of either to show reconstitution of the symbol (indicia) inventory on player command.

Applicant also respectfully submits that the combination of Richardson and Fuchs does not render the invention obvious. The Examiner bears the initial burden of factually supporting a *prima facie* case of obviousness. MPEP § 2142. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of teachings of the references. MPEP §2142.

To establish a *prima facie* case of obviousness, there must be some **suggestion or motivation** (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) **to modify the reference** teachings. The prior art reference (or references when combined) must teach or suggest **all** the claimed limitations. MPEP §2143. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is **some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to those skilled in**

**the art.** *In re Fine* 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.01. A statement that modifications of the prior art, to meet the claimed invention, would have been well within the ordinary skill in the art at the time the claimed invention was made, is not sufficient to establish *prima facie* obviousness without some **objective reason to combine the teachings of the prior art.** MPEP §2143.01. Further, if the proposed modification of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. MPEP §2143.01.

There is no suggestion or disclosure for the combination of the references. As stated above Richardson is directed to a pull-tab game, which is quite different from the game set forth in the claims. Richardson thus does not permit the player to reconstitute the inventory as recited in the claims but instead requires the player to go to a new game. In Richardson when all the major prize winners have been sold, the deal (game remaining set of tickets) may be retired; however the player cannot re-stock or reconstitute the ticket set back to an original number of tickets. Those skilled in the art of pull tab games would not have understood Richardson to allow the player to re-stock the ticket inventory since the same would affect the profitability of the ticket set and the seller and gaming authorities would lose control of the game, as discussed above. . Thus Richardson teaches away from a player being able to reconstitute the game symbol set.

Allowance of claim 6 is respectfully requested.

Claims 7 - 8 depend from claim 6. Claim 8 recites reconstituting the inventory

into a random, serial order, which is not disclosed or suggested in the art. Any conclusion that the prior art cited shows setting the inventory data into a random serial order of 1 - X is as a result of hindsight. For the foregoing reasons allowance of claims 7 -8 is respectfully requested.

Claim 9 is an independent claim drawn along the lines of claim 8, For the reasons advanced above, allowance of claim 9 is respectfully requested.

Claim 10 is an independent claim along the lines of claim 6. For the reasons advanced above, allowance of claim 10 is solicited.

Claim 11 is an apparatus claim which has been amended to include the feature of input apparatus for the player to input a re-shuffle signal to said processor to prompt the processor to reconstitute said indicia inventory to X.. Thus as amended, claim 11 is drawn to features along the lines of claim 6. For the reasons advanced above and the failure of the cited art to disclose or suggest the features of claim 11, allowance of claim 11 is respectfully requested.

Claim 12 depends from claim 11. For the reasons advanced with respect to claim 11, allowance of claim 12 is respectfully requested.

Claim 14 depends from claim 11 to recite features along the lines of claims 8 and 9. For the reasons set forth for allowance of those claims, allowance of claim 14 is requested.

New claim 15 is a method claim which includes the display of data corresponding to the depletion of inventory such that an outcome becomes eliminated. See Spec, page 7, lines 11 - 14. Fuchs ' 753 does not disclose or suggest the features of claim 15, including the feature of displaying information that certain outcomes have been

eliminated by deck depletion. Fuchs '753 in fact teaches away from this feature by providing:

“ In order to **ensure that an adequate number of game symbols is available at all times**, provision can be made that after a certain number of games or after a certain number of game symbols have appeared, **the number of available game symbols can be added.....**” Col 10, lines 1 - 6.

Thus, Fuchs '753 teaches that there must always be an adequate amount of game symbols to provide a chance for winning each winning outcome. Applicant, on the other hand, lets depletion occur even to the point where certain outcomes can become unavailable due to depletion.

Richardson also does not disclose or suggest the features of claim 15. In Richardson, the player purchases and reveals a ticket which has a predetermined symbol combination. In other words, Richardson is directed to a game where all of the outcomes for all of the tickets of the deal, e.g. 10,000 pre-printed or preset tickets, is predetermined and scripted to provide the prizes and profits required for operation of the game. That is, in Richardson, one the ticket(s) with the highest prize is sold and redeemed the deal will not produce another ticket with that prize. With the random selection of indicia to define outcomes, all winning outcomes are available so long as depletion of game symbols does not eliminate a combination. Thus the profit from the method of the present invention is based upon probabilities that certain outcomes will be randomly selected rather than scripting the outcome set of tickets as in Richardson.

Allowance of claim 15 is respectfully requested.

Claims 16-18 depend from claim 15. Claim 16 recites the feature of providing for player reconstitution of the inventory which, as discussed above, is not disclosed in the prior art. Claims 17 and 18 are drawn along the lines of claims 7 and 8 discussed above. Allowance of these claims is also solicited.

New claim 19 is a device claim along the lines of claim 15. For the reasons advanced with respect to claim 15, allowance of claim 19 is requested.

Claims 20-22 depend from claim 19. Claims 20 and 22 are drawn along the lines of claims 7 and 8. For the reasons advanced above, allowance of claims 20 and 22 is requested. Claim 21 is drawn along the lines of claim 12. For the reasons set forth in regard to that claim, allowance of claim 21 is also requested.

#### CONCLUSION

For the reasons advanced above, it is submitted that all pending claims are in condition for allowance. Allowance of all pending claims is solicited. The undersigned requests a telephone interview to discuss any remaining issues.

Respectfully submitted,

ANDERSON & MORISHITA, LLC

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By: 

Philip J. Anderson  
Registration No. 29,887  
Anderson & Morishita, LLC  
2725 S. Jones Blvd  
Suite 102  
Las Vegas, NV 89146  
(702) 222-2113 Phone